

ESTTA Tracking number: **ESTTA275246**

Filing date: **03/31/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161954
Party	Plaintiff PABST BREWING COMPANY
Correspondence Address	WILLIAM B. NASH JACKSON WALKER L.L.P. 112 E. PECAN STREET, SUITE 2100 SAN ANTONIO, TX 78205 UNITED STATES bnash@jw.com
Submission	Plaintiff's Notice of Reliance
Filer's Name	William B. Nash
Filer's e-mail	bnash@jw.com, mfasstold@jw.com, llapidario@jw.com, lstuder@jw.com
Signature	/William B. Nash/
Date	03/31/2009
Attachments	2009-03-31 Opposer's Eighth Notice of Reliance.pdf (82 pages)(4392738 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

	X	
)	
Pabst Brewing Company)	Opposition No. 91161954
Opposer,)	Opposition No. 91161955
)	
v.)	
)	Serial Nos.: 75/883,254 and 75/883,253
Lone Star Steakhouse & Saloon)	Mark: LONE STAR (and Design)
Applicant.)	
	X	

OPPOSER'S EIGHTH NOTICE OF RELIANCE

Opposer, Pabst Brewing Company ("Pabst"), by and through its attorney of record, submits this Eighth Notice of Reliance pursuant to 37 CFR § 2.122(e). Specifically, Opposer relies on Official Records of the U.S. Patent and Trademark Office (TESS database records) evidencing Applicant Lone Star Steakhouse & Saloon, Inc.'s ("Applicant") Trademark Application and Specimens in the file of its pleaded Application Serial No. 75/883,253 filed on December 29, 1999 and published in the *Official Gazette* on March 2, 2004, a copy of which is attached hereto as Exhibit A comprising of the following:

Specimens filed on 12-29-1999

Drawing filed on 12-29-1999

Application filed on 12-29-1999

Office Action Outgoing filed on 03-16-2003

Paper Correspondence Incoming filed on 09-22-2003

Unclassified document filed on 10-18-2003

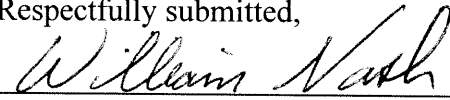
Specimens filed on 10-18-2003

Notice of Publication filed on 02-11-2004

TEAS Revoke Appointed Attorney filed on 07-06-2005.

Dated: March 31, 2009

Respectfully submitted,



William B. Nash, Reg. No. 33,743
Jackson Walker, L.L.P.
112 East Pecan St., Suite 2100
San Antonio, Texas 78205
(210) 978-7700
(210) 978-7790 (Fax)
Attorneys For Opposer Pabst Brewing
Company

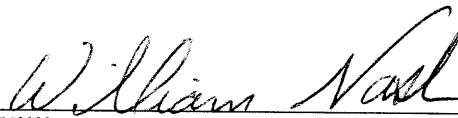
CERTIFICATE OF SERVICE

This is to certify that on this 31st day of March, 2009, a true and correct copy of the foregoing Opposer's Eighth Notice of Reliance was served via electronic mail to the following:

Phillip L. Free, Jr., OBA #15765
Marie S. Johnston, OBA # 19847
Crowe & Dunlevy, P.C.
20 North Broadway, Suite 1800
Oklahoma City, OK 73102-8273

phil.free@crowedunlevy.com

Attorney for Applicant Lone Star Steakhouse & Saloon



William B. Nash
Attorney for Opposer

Exhibit

A

Revocation of Attorney/Domestic Representative and/or Appointment of Attorney/Domestic Representative

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	75883253
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION	
MARK	LONE STAR
ATTORNEY SECTION	
ORIGINAL ADDRESS	JOSEPH J. FERRETTI CROWE & DUNLEVY 22861 (21362 20 NORTH BROADWAY, SUITE 1800 OKLAHOMA CITY, OK 73102-8273
CORRESPONDENCE SECTION	
ORIGINAL ADDRESS	JOSEPH J. FERRETTI CROWE & DUNLEVY 22861 (21362 20 NORTH BROADWAY, SUITE 1800 OKLAHOMA CITY, OK 73102-8273
NEW ATTORNEY ADDRESS	
STATEMENT TEXT	By submission of this request, the undersigned REVOKES the power of attorney currently of record, as listed above, and hereby APPOINTS the following new attorney:
NAME	Phillip L. Free, Jr.
FIRM NAME	Crowe & Dunlevy, P.C.
INTERNAL ADDRESS	Suite 1800
STREET	20 North Broadway
CITY	Oklahoma City

STATE	Oklahoma
COUNTRY	United States
POSTAL/ZIP CODE	73102-8273
PHONE	(405) 235-7700
FAX	(405) 239-6651
EMAIL	IPmail@crowedunlevy.com
ATTORNEY AUTHORIZED TO COMMUNICATE VIA E-MAIL	YES
NEW CORRESPONDENCE ADDRESS	
NAME	Phillip L. Free, Jr.
FIRM NAME	Crowe & Dunlevy, P.C.
INTERNAL ADDRESS	Suite 1800
STREET	20 North Broadway
CITY	Oklahoma City
STATE	Oklahoma
COUNTRY	United States
POSTAL/ZIP CODE	73102-8273
PHONE	(405) 235-7700
FAX	(405) 239-6651
EMAIL	IPmail@crowedunlevy.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	YES
SIGNATURE SECTION	
SIGNATURE	/Phillip L. Free, Jr./
SIGNATORY NAME	Phillip L. Free, Jr.
SIGNATORY DATE	07/06/2005
SIGNATORY POSITION	Attorney for Applicant
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Jul 06 13:03:54 EDT 2005
	USPTO/RAA-12.147.224.62-2

TEAS STAMP

0050706130354432029-78314
404-250bad17c989e7c464bc1
9d6c2b6e896561-N/A-N/A-20
050706122001834972

PTO Form 2196 (Rev 9/2005)
OMB No. 0651-0056 (Exp 09/30/2011)

Revocation of Attorney/Domestic Representative and/or Appointment of Attorney/Domestic Representative

To the Commissioner for Trademarks:

MARK: LONE STAR

SERIAL NUMBER: 75883253

The original attorney

JOSEPH J. FERRETTI

CROWE & DUNLEVY

22861

20 NORTH BROADWAY, SUITE 1800

OKLAHOMA CITY, OK 73102-8273

Original Correspondence Address :

JOSEPH J. FERRETTI

CROWE & DUNLEVY

20 NORTH BROADWAY, SUITE 1800

OKLAHOMA CITY, OK 73102-8273

By submission of this request, the undersigned REVOKES the power of attorney currently of record, as listed above, and hereby APPOINTS the following new attorney:

Newly Appointed Attorney:

Phillip L. Free, Jr.

Crowe & Dunlevy, P.C.

Suite 1800

20 North Broadway

Oklahoma City, Oklahoma 73102-8273

United States

(405) 235-7700

(405) 239-6651

The following is to be used as the correspondence address:

Phillip L. Free, Jr.
Crowe & Dunlevy, P.C.
Suite 1800
20 North Broadway
Oklahoma City, Oklahoma 73102-8273
United States

(405) 235-7700
(405) 239-6651
IPmail@crowedunlevy.com

Signature: /Phillip L. Free, Jr./ Date: 07/06/2005
Signatory's Name: Phillip L. Free, Jr.
Signatory's Position: Attorney for Applicant

Serial Number: 75883253
Internet Transmission Date: Wed Jul 06 13:03:54 EDT 2005
TEAS Stamp: USPTO/RAA-12.147.224.62-2005070613035443
2029-78314404-250bad17c989e7c464bc19d6c2
b6e896561-N/A-N/A-20050706122001834972

Commissioner for Trademarks
2900 Crystal Drive
Arlington , VA 22202-3514
www.uspto.gov

Feb 11, 2004

NOTICE OF PUBLICATION UNDER 12(a)

- | | |
|-------------------------------------|--|
| 1. Serial No.:
75/883,253 | 2. Mark:
LONE STAR |
| 3. International Class(es):
25 | |
| 4. Publication Date:
Mar 2, 2004 | 5. Applicant:
Lone Star Steakhouse & Saloon, Inc. |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a certificate of registration.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: (202) 512-1800

By direction of the Commissioner.

Correspondence Address:

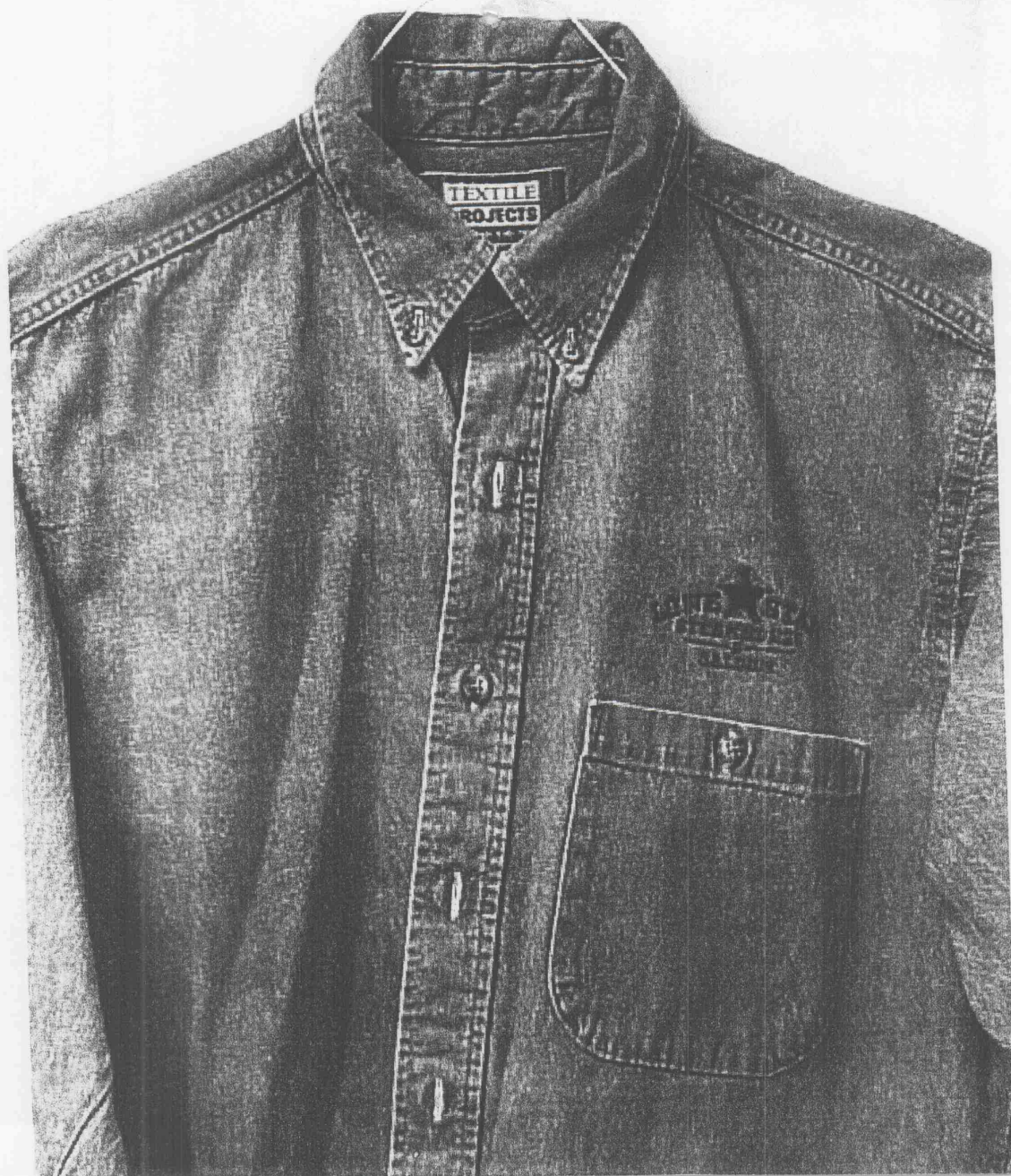
JOSEPH J. FERRETTI
CROWE & DUNLEVY
1800 MID-AMERICA TOWER
20 NORTH BROADWAY, SUITE 1800
OKLAHOMA CITY, OK 73102-8273

TMP&I

75883253



75883253



Trademark

75883253

TRADEMARK



75883253

RECEIVED

JUN 12 2000

LAW OFFICE 101

PROSECUTION HISTORY

Entry	Date	Initials
1. JUN 8 2000 LAW OFFICE 101	AUG 29 2000	LW
2. Prop LTR	3-07-01	APR 13 2001
3. ABANDONED FOR LATE RESPONSE	3-01-01	RPR
4.		
5.		
6. ABANDONED MAR -- 2001		
7.		
8. LTR Cdx M 2/28/01	07/13/01	SEP - 6 2001
9.	DEC 18 2001	a
10. Susp Status Check 4/22/03	MAR 18 2003	dx
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30.		



12-29-1999

U.S. Patent & TMOfo/TM Mail Rcpt Dt. #31

APPLICANT: Lone Star Steakhouse & Saloon, Inc.,
a Delaware Corporation

ADDRESS: 224 E. Douglas, Suite 700, Wichita, KS 67202

DATE OF FIRST
USE: October 12, 1989

DATE OF FIRST
USE IN COMMERCE: October 12, 1989

GOODS: Clothing, namely T-shirts, men's and women's sport shirts, sweat
shirts, polo shirts and caps.

LONE STAR

ABANDONED
MAR - - 2001

TRADEMARK



75883253

*** User: rraju ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	1665	N/A	0	0	0:01	*lone*[bi,ti]
02	422	186	236	236	0:01	1 and "025"[cc]
03	18572	N/A	0	0	0:02	*star*[bi,ti] or *ztar*[bi,ti]
04	4458	N/A	0	0	0:02	3 and "025"[cc]
05	1094	N/A	0	0	0:02	3 and "025"[ic]
06	10080	N/A	0	0	0:01	star[bi,ti]
07	2333	N/A	0	0	0:02	6 and "025"[cc]
08	622	N/A	0	0	0:01	6 and "025"[ic]
09	40608	N/A	0	0	0:06	*l{v}n{v}*[bi,ti]
10	2216	N/A	0	0	0:02	*sta{v}r*[bi,ti] or *zt{v}r*[bi,ti]
11	26	13	1	1	0:01	9 and 10
12	66628	N/A	0	0	0:02	*st{v}r*[bi,ti] or *zt{v}r*[bi,ti]
13	173	84	57	57	0:01	10 and 12
14	890	N/A	0	0	0:01	9 and 12
15	286	117	169	169	0:01	14 and "025"[cc]

Session started 8/4/00 10:49:32 AM

Session finished 8/4/00 11:05:54 AM

Total search duration 0:26 minutes

Session Duration 16:22 minutes

Default NEAR limit= 1 ADJ limit= 1

RECEIVED FILE THROUGH CO-PENDING POLICY.

*** User: RCrowe ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	17567	N/A	0	0	0:01	010103[DC]
02	68	33	22	35	0:01	(*lone*)[bi,ti] and 1
03	144	73	71	71	0:01	(*lone*)[bi,ti] and (*star*)[bi,ti] not 2
04	72	36	36	36	0:01	(*take* and *way*)[bi,ti]

Session started 6/19/00 1:06:00 PM

Session finished 6/19/00 3:12:36 PM

Total search duration 0:04 minutes

Session Duration 6:36 minutes

Default NEAR limit= 1 ADJ limit= 1

Incoming Correspondence Routing Sheet

To: TMO LAW OFFICE 110 - AWAITING RESPONSE DOCKET

Word Mark: LONE STAR

Serial No: 75883253



Mail Date: 09222003



Doc. Type: Responses to Office Actions



No Fee

RAM Mail Date: 092203





CROWE & DUNLEVY
ATTORNEYS AND COUNSELORS AT LAW
100 Years • 1902 - 2002

JOSEPH J. FERRETTI
Direct Tel: 405.235-7744
Direct Fax: 405.272.5256

ferrettj@crowedunlevy.com

September 18, 2003

Express Mail Receipt No. EV085805973US

Deposited on September 18, 2003

Box RESPONSES - NO FEE

Law Office 101

Commissioner for Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3513

Re: Applicant's Response to the Office Action Mailed March 18, 2003
Applicant: Lone Star Steakhouse & Saloon, Inc.
Serial No. 75/883,253
Trademark: LONE STAR
Filed: December 29, 1999

Dear Commissioner:

Enclosed please find the following documents relating to the above-referenced mark:

1. Applicant's Response to the Office Action Mailed March 18, 2003, and
2. An acknowledgment postcard.

Please acknowledge your receipt of these documents by placing your receipt stamp on the enclosed postcard and returning it to us. The above documents are being sent by Express Mail Receipt No. EV085805973US on Thursday, September 18, 2003.

It is believed that no fees are required in connection with this Response; however, should fees be required, you are hereby authorized to charge same to Deposit Account No. 13-0110.



09-22-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #39

Sincerely,

Joseph J. Ferretti
For the Firm

JJF/kas

Enclosures

cc: Lone Star Steakhouse & Saloon, Inc.

1282328.1

TULSA
500 KENNEDY BUILDING
321 SOUTH BOSTON AVENUE
TULSA, OK 74103-3313
TEL: 918.592.9800 • FAX: 918.592.9801

OKLAHOMA CITY
20 NORTH BROADWAY, SUITE 1800
OKLAHOMA CITY, OK 73102-8273
TEL: 405.235.7700 • FAX: 405.239.6651

NORMAN
THE HIFPOINT OFFICE BUILDING
2500 SOUTH MCGEE, SUITE 140
NORMAN, OK 73072-6705
TEL: 405.321.7317 • FAX: 405.360.4002

EXPRESS MAIL RECEIPT NO. EV085805973US
DEPOSITED ON SEPTEMBER 18, 2003

SERVICE MARK
Dkt. TM1325US25

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	LONE STAR STEAKHOUSE)	
	& SALOON, INC.)	
)	Examining Attorney Katherine Stoides
)	Law Office: 101
Serial No.:	75/883,253)	
)	Response to Office Action
Filed:	December 29, 1999)	Mailed: 03/18/03
)	
Mark:	LONE STAR)	

BOX RESPONSES - NO FEE
Law Office 101
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

**APPLICANT'S RESPONSE TO
OFFICE ACTION MAILED MARCH 18, 2003**

This is in response to the second Office Action mailed March 18, 2003. Please find the enclosed remarks in response to the second Office Action.

REMARKS

I. Refusal of Registration Based on Likelihood of Confusion

The present trademark application was filed December 29, 1999. In the second Office Action mailed March 18, 2003, the Examining Attorney refused registration of the Applicant's mark LONE STAR on the Principal Register on the basis that the applicant's mark is likely to be confused with the mark LONE STAR CLASSIC, registration number 2,589,026. The applicant responds to the refusal to register and respectfully submits that registration is proper.

As indicated by the Examining Attorney, the Court in *In re DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) listed factors to be considered in determining whether there is a likelihood of confusion. The Applicant submits that consideration of the *DuPont* factors suggests that there is no likelihood of confusion between the registrant's and the applicant's marks.

Although the Office Action cites the *DuPont* factors, only two of the factors appear to have been considered by the Examining Attorney. These factors, the similarity of the marks and the similarities of the goods, have been used to come to a conclusion that there is a likelihood of confusion between the marks at issue. However, it is respectfully submitted that an examination of all the *DuPont* factors demonstrates that there is no likelihood of confusion.

In addition, as will be highlighted below in the discussion of the *DuPont* factors, in 2001, Applicant and Registrant entered into an agreement (the "Agreement") whereby the parties agreed to limitations upon use of their respective Marks to ensure that there would, in fact, be no likelihood of confusion. (See Exhibit "A"). Applicant submits that based upon the limitations prescribed in the agreement, that there is no likelihood of confusion – and there has been no actual confusion as well.

A. Channels of Trade

One of the *DuPont* factors, namely the similarity of established, likely to continue trade channels, supports a finding of no likelihood of confusion. *Id.* Dissimilarity in trade channels negates that confusion is not likely. The Applicant sells its goods from stores in its chain of restaurants, for sale on the premises. Products of the Registrant will not be on sale in Applicant's restaurant – or in any restaurant pursuant to the Agreement – and therefore there is no remote possibility of similar trade channels. Since the Applicant's goods are limited to sales in association with its own restaurants, the dissimilar trade channels preclude a finding of likelihood of confusion.

B. Conditions at Purchase

In a related *DuPont* factor, the conditions under which and buyers to whom sales are made is considered. *Id.* This factor considers the mind-set of buyers and includes the care exercised by buyers. Buyers purchasing the goods of the Applicant will be in Applicant's restaurants (which share the same name as that of the Applicant's mark). Barring exceptional circumstances, buyers will know that they are in the Applicant's restaurants and are not likely to confuse the goods of the Applicant with any other source. As stated above, Registrant's goods will never be sold in restaurants or similar type establishments (See Agreement).

C. Fame of Prior Mark

Another *DuPont* factor considers the fame of the prior mark. *Id.* A prior mark that is not particularly famous is less likely to be confused with another mark. Although the Registrant's mark has apparently enjoyed over a decade of use and is likely known in circles familiar with junior volleyball in which it presides, it is unlikely that the Registrant's mark has achieved the level of fame that would cause confusion between the Registrant's and the Applicant's marks. Also, since Applicant's goods are sold in its restaurants and not at volleyball events, this factor also demonstrates no likelihood of confusion.

D. Actual Confusion

DuPont also considers evidence of actual confusion during the time of concurrent use. *Id.* A lack of evidence of actual confusion also suggests that a likelihood of confusion does not exist. In the present case, both the Registrant and the Applicant claim over a decade of use, yet the Office Action does not present a single incident of actual confusion between the marks. Likewise, the Applicant has been presented with no incident of actual confusion, another factor that suggests confusion is not likely. In fact, the Agreement sets forth specific limitations to prevent actual confusion from occurring.

E. Market Interface

The market interface between the Registrant and Applicant is also considered by *DuPont*. *Id.* The two parties have no desire to cause confusion and are in agreement as to the separate and distinct nature of each others' uses. Additionally, the two parties have agreed in writing, *inter alia*, to pursue separate marketing channels. (See the Agreement.)

F. Right to Exclude

DuPont also considers the extent to which the Applicant has a right to exclude others from use of its mark on its goods. *Id.* A greater right to exclude on the part of the Applicant falls in favor of no likelihood of confusion. The Applicant has been using the proposed mark since the late 1980s for the listed goods and has several other registered marks that use the "Lone Star" Mark. Among these registered marks are registration numbers 1155907, 1731247, 2226931, 2229771, and others. Federal and common law rights have been developed by the Applicant in the mark at issue, and this extent of rights again suggests that a likelihood of confusion does not exist.

G. Potential Confusion

The *DuPont* Court also addressed whether the extent of potential confusion is de minimis or substantial. *Id.* Obviously, the less potential confusion between the marks suggests less of a likelihood of confusion. As suggested by the factors addressed above, any confusion between the goods represented by the marks at issue would be cursory, and confusion between the marks is simply not likely—especially considering the precautions taken by Applicant and Registrant pursuant to the Agreement.

H. Conclusion

The weight given to particular *DuPont* factors may differ among those determining a likelihood of confusion. *Id.* at 567. However, in full recognition of these differences the Applicant submits that the dissimilarity of established, likely to continue trade channels should carry substantial weight. This is especially in light of the precautions taken by Applicant and Registrant in the Agreement to ensure that there is no likely, nor has there been any actual, confusion.

Similarly, none of the factors cited above indicate that confusion is likely between the marks at issue, as the sheer number of factors support registration of the present mark. The Applicant respectfully requests that the refusal to register be withdrawn and the application be approved for publication.

II. Informality Regarding Geographic Origin

The Examiner has requested that Applicant identify the geographic origin of the goods related to the application. Applicant's goods will be sold in its restaurants in the following states, Alabama, Alaska, Arizona, Arkansas, California, Colorado, Delaware, Florida, Georgia, Idaho, Illinois, Indiana, Iowa, Kansas, Kentucky, Louisiana, Maine, Maryland, Massachusetts, Michigan, Mississippi, Missouri, Nebraska, Nevada, New Jersey, New Mexico, New York, North Carolina, North Dakota, Ohio, Oklahoma, Pennsylvania, Rhode Island, South Carolina, South Dakota, Tennessee, Utah, Virginia, West Virginia, Wisconsin, as more particularly identified on its website at: www.lonestarsteakhouse.com/LocationSearch.asp.

III. Continuance of Sections 2(e)(2) and 2(e)(3).

As the Examiner has continued the refusals relating to Sections 2(e)(2) and 2(e)(3), Applicant herein re-incorporates its response previously filed with the PTO on February 28, 2001 and reserves the right to further address this issue to the extent the Examiner raises the issue in the future.

IV. Conclusion

For the aforementioned reasons – particularly because Applicant and the cited Registrant have entered into the Agreement which takes measures to ensure that there is no likelihood of confusion between their respective Marks – Applicant respectfully submits that registration of Applicant's Mark is proper.

Respectfully submitted,



Joseph J. Ferretti
CROWE & DUNLEVY, P.C.
1800 Mid-America Tower
20 N. Broadway
Oklahoma City, Oklahoma 73102-8273
Telephone No.: (405) 235-7744
Fax No.: (405) 272-5256

Attorney for Applicant

SETTLEMENT AGREEMENT

This Agreement is made by and between Lone Star Steakhouse & Saloon, Inc. ("LSS&S"), a Delaware corporation with its principal place of business in Wichita, Kansas, and Junior Volleyball Association of Austin ("JVAA"), a Texas non-profit corporation with offices in Austin, Texas. This Agreement is effective as of the date it has been signed by the parties.

WHEREAS, LSS&S is engaged, *inter alia*, in the business of providing restaurant services and selling various clothing items in interstate commerce and in connection therewith has used the service marks and trademarks LONE STAR, LONE STAR CAFE and LONE STAR STEAKHOUSE & SALOON;

WHEREAS, LSS&S is the owner of the United States Trademark and Service Mark Registrations and applications for Registration listed in the attached **Exhibit A** for marks containing or comprising the term "LONE STAR" as used in connection with both restaurant services and clothing, which trademarks and service marks are still in use and which registrations are valid and in full force and effect;

WHEREAS, JVAA is engaged, *inter alia*, in the business of organizing and sponsoring volley ball tournaments in Texas under the service mark LONE STAR CLASSIC, and in connection therewith is has sold and sells clothing under the trademark LONE STAR CLASSIC;

WHEREAS, JVAA has filed use-based Applications to register the service mark and trademark LONE STAR CLASSIC, for entertainment services in the nature of

EXHIBIT A

volleyball tournaments, in International Classes 16, 25, and 41 as set forth fully in the attached **Exhibit B**;

WHEREAS, the parties desire to avoid any conflict or confusion that might arise from their concurrent use and registration of their respective marks;

NOW, THEREFORE, in consideration of the mutual promises, releases, and covenants hereinafter set forth, the parties agree as follows:

1. JVAA acknowledges that LSS&S's above-identified trademarks and service marks are valid; acknowledges that LSS&S's above-identified trademark and service mark registrations and applications for registration are valid; and agrees not to challenge or object to LSS&S's use or registration of the marks LONE STAR, LONE STAR CAFE, LONE STAR STEAKHOUSE AND SALOON, LONE STAR TAKE AWAY, LONE STAR STATE OF MIND, or any other mark containing or comprising the term "LONE STAR" and used or proposed for use in connection with restaurant and bar services or clothing.

2. JVAA may continue to use and seek to register the mark LONE CLASSIC in connection with its services and on clothing associated therewith and distributed directly by JVAA at volleyball tournaments, over the Internet or through the mail, or distributed through retail sporting goods or clothing stores. JVAA, however, agrees never to use the mark LONE STAR CLASSIC, or any other mark containing or comprising the terms "LONE STAR" or "LONESTAR" on or in connection with clothing that is distributed to or through, or in association with, restaurants, bars, or other establishments associated with the sale of foods or beverages.

3. JVAA agrees never to seek to register the mark LONE STAR CLASSIC, or any other mark containing or comprising the terms "LONE STAR" or "LONESTAR" on

or in connection with restaurant services. JVAA further agrees never to use or seek to register any mark containing or comprising the words "LONESTAR" or "LONE STAR" in combination with the trade name or service mark of any restaurant, bar, or other establishment associated with the sale of food or beverages, or the words "saloon", "steakhouse", "steaks", or "cafe", in connection with any goods or services.

4. Provided that JVAA complies with the restrictions set forth herein, LSS&S agrees not to challenge JVAA's continued use of the mark LONE STAR CLASSIC or any other mark containing or comprising the words "LONE STAR" on or in connection with the goods and services set forth in **Exhibit B**.

5. LSS&S further agrees not to use or seek to register any trademark or service mark containing or comprising the words "LONE STAR" on or in connection with organizing and conducting volleyball games, volleyball competitions, volleyball sporting events, or volleyball tournaments, or selling or offering for sale volleyball-related sporting equipment.

6. This Agreement and **Exhibits A and B** attached hereto constitute the entire agreement between the parties and may not be changed orally, but only by an agreement in writing signed by the party against whom enforcement is sought.

7. This Agreement shall be binding upon and shall inure to the benefit of the parties, their successors, assigns, subsidiaries, licensees, affiliated companies and all those in active concert or participation with them.

ACCEPTED AND AGREED:

LONE STAR STEAKHOUSE
& SALOON, INC.

Dated: 4-23-01

By Gerald T. Aaron

Name: Gerald T. Aaron

Its: Sr. Vice President - Counsel

JUNIOR VOLLEYBALL ASSOCIATION OF AUSTIN

Dated: _____

By [Signature]

Name:

Its: DIRECTOR

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 75/883253

MAR 18 2003

APPLICANT: Lone Star Steakhouse & Saloon, Inc.

CORRESPONDENT ADDRESS:

JOSEPH J. FERRETTI
CROWE & DUNLEVY
1800 MID-AMERICA TOWER
20 NORTH BROADWAY, SUITE 1800
OKLAHOMA CITY, OK 73102-8273

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ecom110@uspto.gov

MARK: LONE STAR

CORRESPONDENT'S REFERENCE/DOCKET NO: 22861 (21362)

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 75/883253

The Office has reassigned this application to the undersigned examining attorney.

As U.S. Application Serial No. 75-775808 has matured into U.S. Registration No. 2589026, action on this application is resumed.

SECTION 2(d) REFUSAL -- Likelihood Of Confusion

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on the identified goods, is likely to be confused with the registered mark in U.S. Registration No. 2589026. TMEP section 1207. See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. In re E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney

must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. In *re* August Storck KG, 218 USPQ 823 (TTAB 1983); In *re* International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The examining attorney has determined that contemporaneous use of the marks LONE STAR and LONE STAR CLASSIC, as applied to clothing, would be likely to cause confusion for the following reasons.

The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods.

A. The Marks

The examining attorney must look at the marks in their entireties under Section 2(d). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. In *re* National Data Corp., 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). In *re* J.M. Originals Inc., 6 USPQ2d 1393 (TTAB 1988).

While the examining attorney cannot ignore a disclaimed portion of a mark and must view marks in their entireties, one feature of a mark may be more significant in creating a commercial impression. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). Disclaimed matter is typically less significant or less dominant.

Application of the above standards clearly indicates that the dominant feature of both marks is the same phrase LONE STAR. The addition of the disclaimed, descriptive term CLASSIC is of little, if any, trademark significance. When the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b).

And finally, if the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as

would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980). TMEP §1207.01(b).

B. The Goods

Both parties identify goods that are, in part, identical -- t-shirts, caps and polo shirts. The applicant is advised that the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Corning Glass Works, 229 USPQ 65 (TTAB 1985); In re Rexel Inc., 223 USPQ 830 (TTAB 1984); Guardian Products Co., Inc. v. Scott Paper Co., 200 USPQ 738 (TTAB 1978); In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

C. Conclusion

For the foregoing reasons, the applicant's LONE STAR is refused registration under Section 2(d) of the Trademark Act.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

INFORMALITY

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informality.

Geographic Origin

The applicant must identify the geographic origin of the goods. 37 C.F.R. §2.61(b).

SECTIONS 2(e)(2) and 2(e)(3) REFUSALS – Continued

Pending the applicant's response to the above informality, the refusals under Sections 2(e)(2) and 2(e)(3) are CONTINUED.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Katherine Stoides/
Examining Attorney
Law Office 110
(703) 308-9110 ext.166

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

Attachment 1: 75775808P001OF002.JPG

Print: Mar 16, 2003

75775808

LONE STAR CLASSIC

Serial Number

75775808

Status

REGISTERED

Word Mark

LONE STAR CLASSIC

Registration Number

2589026

Date Registered

2002/07/02

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Junior Volleyball Association of Austin NON-PROFIT CORPORATION TEXAS
2026 Guadalupe Street, Suite 302 Austin TEXAS 78705

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Clothing,
namely t-shirts, caps shorts, and polo shirts. First Use: 1992/04/01.
First Use In Commerce: 1992/04/01.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CLASSIC" APART FROM
THE MARK AS SHOWN.

Section 2f Statement

2(F) ENTIRE MARK

Filing Date

1999/08/06

Serial No.: 75883253

[Images] Page 6 of 6
Printed: 3/16/03 5:50:49 PM

Attachment 2: 75775808P002OF002.JPG

Print: Mar 16, 2003

75775808

Examining Attorney
STOIDES, KATHERINE

Attorney of Record
Diana K. Borden

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. 75/883253 Lone Star Steakhouse & Saloon, Inc.		APPLICANT LONE STAR		PAPER NO. Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 www.uspto.gov <small>If no fees are enclosed, the address should include the words "Box Responses - No Fee."</small>	
MARK LONE STAR		ADDRESS JOSEPH J. FERRETTI CROWE & DUNLEVY 1800 MID-AMERICA TOWER 20 NORTH BROADWAY, SUITE 1800 OKLAHOMA CITY, OK 73102-8273		ACTION NO. 03 MAILING DATE 12/18/01 REF. NO. 22861 (21362)	
FORM PTO-1525 (5-90)		U.S. DEPT. OF COMM. PAT. & TM OFFICE		Please provide in all correspondence: 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.	

RE: Serial Number: 75/883253

☐ The examining attorney has searched the Office records and has found no similar registered mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

- ☒ 1. Action on this application is suspended pending the disposition of:
- ☐ Cancellation No(s).
 - ☐ Opposition No(s).
 - ☐ Civil Action No(s).
 - ☐ Concurrent Use No(s).

If the applicant is a party to the above proceeding, the applicant should advise the Examining Attorney of the outcome of the proceeding when it is terminated.

☒ Application Serial No(s). 75-775808

Since applicant's effective filing date is subsequent to the effective filing date of the above-identified application(s), the latter, if and when it registers, may be cited against this application. See 37 C.F.R. §2.83. A copy of information relevant to this pending application(s) is attached ⁶ was sent previously.

The applicant may request that the application be removed from suspension by presenting arguments related to the potential conflict between the relevant applications or other arguments related to the ground for suspension. The applicant's election to present or not to present arguments at this time will not affect the applicant's right to present arguments later.

☐ 2. Action on this application is suspended pending receipt of a certification or certified copy of the registration in the country of origin of applicant. If the registration is in a foreign language, an English translation must be submitted. The certification or certified copy of the registration should be forwarded to the Examining Attorney as soon as possible. If the foreign application is abandoned, the Examining Attorney should be advised.

☐ 3. It is noted that an assignment involving this application is presently pending before the Office. Action is suspended on this application pending recordation of the assignment. This application will be removed from suspended status upon recordation of the assignment. Notification of recordation is normally done through Office channels. However, upon receipt of the reel and frame number of the assignment, applicant should advise the Examining Attorney. See 37 C.F.R. Part 3.

☐ 4. Action on this application is suspended for ^ months until the Examining Attorney can determine whether the cited registration will be canceled under §8 or expire under §9. 37 C.F.R. 2.67.

☒ 5. The examining attorney has considered the applicant's arguments carefully, but remains unpersuaded. Consequently, the refusals under Section 2(e)(2) and 2(e)(3) are CONTINUED.

As the referenced, earlier-filed application Serial No. 75-273718 has been abandoned, reference to it as a potential bar to registration is hereby WITHDRAWN.

Katherine Stoides
 EXAMINING ATTORNEY NAME

EXAMINING ATTORNEY SIGNATURE

109
 LAW OFFICE

(703) 308-9109 ext. 154
 PHONE

TRADEMARK EXAMINATION WORKSHEET

☒ AMENDMENT STAGE
 ☒ NO CHANGE
 ☐ PUBLICATION/REGISTRATION STAGE

Name: MACY L.O. 109 Date 09/14/01 Serial No. (75) 76 883253

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

Legal Instrument Examiner (LIE)

	Amended	Data Element	
Class Data	<input type="checkbox"/>	<input type="checkbox"/> Prime/International Class	<input type="checkbox"/> Goods and Services
	<input type="checkbox"/>	<input type="checkbox"/> First Use Date	<input type="checkbox"/> First Use in Commerce Date
	<input type="checkbox"/>	<input type="checkbox"/> In Another Form	<input type="checkbox"/> Certification
	<input type="checkbox"/>	<input type="checkbox"/> 1b	
Mark Data	<input type="checkbox"/>	<input type="checkbox"/> Word Mark	<input type="checkbox"/> Pseudo Mark
	<input type="checkbox"/>	<input type="checkbox"/> Mark Drawing Code	<input type="checkbox"/> Design Search Code
	<input type="checkbox"/>	<input type="checkbox"/> Scan Sub Drawing	
Misc. Mark Data	<input type="checkbox"/>	<input type="checkbox"/> Mark Description	<input type="checkbox"/> Disclaimer
	<input type="checkbox"/>	<input type="checkbox"/> Lining/Stippling	<input type="checkbox"/> Name/Portrait/Consent
	<input type="checkbox"/>	<input type="checkbox"/> Translation	
Section 2(f)	<input type="checkbox"/>	<input type="checkbox"/> Section 2(f) Entire Mark	
	<input type="checkbox"/>	<input type="checkbox"/> Section 2(f) Limitation Statement	<input type="checkbox"/> Section 2(f) in Part
	<input type="checkbox"/>	<input type="checkbox"/> Amended Register	<input type="checkbox"/> Amended Register Date
Foreign Reg. Data	<input type="checkbox"/>	<input type="checkbox"/> Foreign Country	<input type="checkbox"/> 44(d)
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Application Number	<input type="checkbox"/> Foreign Application Filing Date
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Registration Number	<input type="checkbox"/> Foreign Registration Date
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Registration Expiration Date	<input type="checkbox"/> Foreign Renewal Reg. Number
	<input type="checkbox"/>	<input type="checkbox"/> Foreign Reg. Renewal Expiration Date	<input type="checkbox"/> Foreign Renewal Reg. Date
Owner Data	<input type="checkbox"/>	<input type="checkbox"/> Owner Name	<input type="checkbox"/> DBA/AKA/TA
	<input type="checkbox"/>	<input type="checkbox"/> Address 1	<input type="checkbox"/> Address 2
	<input type="checkbox"/>	<input type="checkbox"/> City	<input type="checkbox"/> State
	<input type="checkbox"/>	<input type="checkbox"/> Zip Code	
	<input type="checkbox"/>	<input type="checkbox"/> Citizenship	<input type="checkbox"/> Entity
	<input type="checkbox"/>	<input type="checkbox"/> Entity Statement	<input type="checkbox"/> Composed of
	<input type="checkbox"/>	<input type="checkbox"/> Assignment(s)/Name Change	
Amd/Corr Restr.	<input type="checkbox"/>	<input type="checkbox"/> Concurrent Use	
Prior U.S. Reg.	<input type="checkbox"/>	<input type="checkbox"/> Prior Registration	
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	<input type="checkbox"/>	<input type="checkbox"/> Attorney Docket Number	
	<input type="checkbox"/>	<input type="checkbox"/> Correspondence Firm Name/Address	

I certify that all corrections have been entered in accordance with text editing guidelines.

MACY
 LIE

09/14/01
 DATE

Other: _____

EXPRESS MAIL RECEIPT NO. EL638306423US
DEPOSITED ON February 28, 2001

TRADEMARK
22861

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: LONE STAR STEAKHOUSE
& SALOON, INC.

Serial No.: 75/883253

Filed: December 29, 1999

Mark: LONE STAR

)
)
) Examining Attorney Radhika Raju
) Law Office: 109
)

) Response to Office Action
) Mailed: 08/29/00
)

FKP DAK
9/28/01 have we heard from PTO re response?
OR filed 7/28/01?

BOX RESPONSES - NO FEE
Law Office 101
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

**APPLICANT'S RESPONSE TO
OFFICE ACTION MAILED AUGUST 29, 2000**

Applicant, Lone Star Steakhouse & Saloon, Inc., herein responds to the Office Action dated August 29, 2000. Applicant respectfully submits that Applicant's Mark is entitled to registration because the PTO has failed to demonstrate that Applicant's Mark is either primarily geographically deceptively misdescriptive or geographically descriptive.

I. Applicant's Mark Is Not Primarily Geographically Deceptively Misdescriptive.

Applicant respectfully submits that the Examiner has not presented a *prima facie* case establishing that Applicant's Mark is primarily geographically deceptively misdescriptive.

To establish a *prima facie* case for refusal to register a Mark as primarily geographically deceptively misdescriptive under §2(e)(3), the Examining must establish the following:

- (1) the primary significance of the Mark is geographic;
- (2) purchasers would be likely to think that the goods originate in the geographic place identified in the Mark, i.e., purchasers would make a goods/place association; and
- (3) the goods do not originate in the place identified in the Mark.

TMEP §1210.06. Further, to satisfy its *prima facie* burden for refusing to register the Mark, all three elements must be met.

With regard to the first element, Applicant respectfully submits that the Examiner has not established that the "primarily" significance of the proposed Mark, LONE STAR, is that of geographic location. Although dictionary definitions may be useful to glean the "primary" significance of a Mark, the Examiner did not provide the dictionary definition of "LONE STAR." Rather, the Examiner cited to the definition of "TEXAS" which simply states as follows:

"Nickname: Lone Star State."

See attachment to 8/29/00 Office Action.

Reliance upon the above definition fails to satisfy the Examiner's burden for two reasons. One, this definition does not establish that the *primary* significance of LONE STAR is that of geographic location. Rather, this definition simply notes - *under the definition of TEXAS* - that "LONE STAR STATE" is a nickname for Texas. Because this is not the definition for LONE STAR, one cannot determine whether the primary, the secondary or even the tertiary significance of "LONE STAR" is that of geographic location; one can only determine that *one of the significances* (of LONE STAR STATE) relates to TEXAS.

Two, the dictionary indicates that the nickname for TEXAS is the "LONE STAR STATE." Applicant's Mark, however, is not "LONE STAR STATE." Rather, Applicant's Mark is simply "LONE STAR." Were Applicant using LONE STAR STATE as its Mark, there may be grounds for concluding a geographic significance, i.e. Texas, as the dictionary suggests. However, Applicant is simply using the Mark LONE STAR, *without the geographic reference to "STATE."* Thus, on its face the cited dictionary reference does not support a finding that the significance (which must be "primary") of Applicant's Mark is that of geographic location. For these two reasons, Applicant respectfully submits that the first element has not been satisfied.

With regard to the second element - the establishment of a goods/place association - the record is bare of any such evidence. A refusal under §2(e)(3) requires the Examiner to submit evidence establishing a goods/place association, such that the public is likely to believe that the goods originate in the place identified in the Mark. TMEP§1210.04. Because no goods/place association has been made, the *prima facie* case has not been established and there can be no finding that Applicant's Mark is primarily geographically deceptively misdescriptive. *See, In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (C.C.P.A. 1982) (NANTUCKET held not primarily geographically deceptively misdescriptive of men's shirts originating in North Carolina because of no persuasive evidence of a goods/place association).

Thus, while the PTO must establish all three elements to satisfy its *prima facie* case to refuse registration, Applicant respectfully submits that two of the three elements are lacking. The first element has not been satisfied as there has been no showing of "primary" significance. The second element is lacking because there is no evidence in the record supporting a goods/place association.

II The Mark is Not Geographically Descriptive.

To establish a *prima facie* case for refusal to register a Mark as geographically descriptive under §2(e)(2), the Examining must establish each the following elements:

- (1) the primary significance of the Mark is geographic;
- (2) purchasers would be likely to think that the goods originate in the geographic place identified in the Mark, *i.e.*, purchasers would make a goods/place association; **and**
- (3) the Mark identifies the geographic origin of the goods.

TMEP §1210.05.

Applicant respectfully submits that the Examiner has similarly failed to establish its *prima facie* case that Applicant's Mark is geographically descriptive. For the same reasons identified above, Applicant submits that the first two elements have not been established.

First, there has been no showing that 'a' significance of the Mark LONE STAR is geographic – the test, however, requires "primary" significance. While 'a' showing has been made concerning LONE STAR STATE, this is not Applicant's Mark – Applicant does not include the geographic reference to "STATE" in its Mark. Second, there is no evidence in the record establishing a goods/place association. TMEP §1210.04. *See also, In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 849-850 (TTAB 1982) (goods/place association must be established by examiner if there is question as to whether the primary significance is geographic).

Thus, Applicant's Mark is not geographically descriptive, and therefore, registration is proper.

CONCLUSION

Thus, based on the above, Applicant respectfully submits that registration of Applicant's Mark is proper.

Respectfully submitted,



Joseph J. Ferretti
CROWE & DUNLEVY, P.C.
1800 Mid-America Tower
20 N. Broadway
Oklahoma City, Oklahoma 73102-8273
Telephone No.: (405) 235-7744
Fax No.: (405) 272-5256
Attorney for Applicant

Box RESPONSES - NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513



02-28-2001

U.S. Patent & TMO/TM Mail Rpt Dt. #76

Re: Response to the Office Action Mailed August 29, 2000
Applicant: Lone Star Steakhouse & Saloon, Inc.
Serial No. 75/883253 Trademark: LONE STAR
Filed: December 29, 1999

Please acknowledge your receipt of the Response to Office Action by placing your receipt stamp on this postage prepaid postcard and return. The enclosures were transmitted by express mail receipt #EL 638306423US on Wednesday, February 28, 2001.

RECEIVED

Joseph J. Ferretti, OBA #15231

C&D 21362-00001

MAR 14 2001

Dkt: 22861

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Time In 9 25 PM	Military <input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day	Return Receipt Fee
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(405) 321-7317
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E-MAIL ferrettj@crowedunlevy.com

February 28, 2001

Via Express Mail EL638306423US

EL638306423US

Box RESPONSES - NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Response to the Office Action Mailed August 29, 2000
Applicant: Lone Star Steakhouse & Saloon, Inc.
Serial No. 75/883253
Trademark: LONE STAR
Filed: December 29, 1999

Dear Commissioner:

Enclosed please find the following documents relating to the referenced mark:

- ▶ Response to the Office Action Mailed August 28, 2000; and
- ▶ an acknowledgment postcard.

Please acknowledge your receipt of these documents by placing your receipt stamp on the enclosed postcard and returning it to us. The above documents are being sent by Express Mail Receipt No. EL638306423US.

It is believed that no fees are required in connection with this Response; however, should fees be required, you are hereby authorized to charge same to Deposit Account No. 13-0110.

Sincerely,



Joseph J. Ferretti
For the Firm

JJF:kay
Enclosures

cc: Gerald Aaron

ATTN: RADHIKA RAJU, OFFICE 109
S/N: 75/883,253 (LONE STAR)

CROWE & DUNLEVY

A Professional Corporation
1800 Mid-America Tower
20 North Broadway
Oklahoma City, OK 73102
(405) 235-7700
FAX (405) 239-6651

SENT

TELECOPIER COVER LETTER

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CITY: Arlington, VA
TELEPHONE: 703-308-9109 ext. 196
TELECOPY NO.: 703-308-7194
FROM: Joseph J. Ferretti/Kathy A. Stanka.
DATE SENT: July 3, 2001
CLIENT/MATTER NO.: 21362-00001
S/N: 75/883,253 Mark: LONE STAR

TOTAL NUMBER OF PAGES SENT, INCLUDING THIS PAGE: 7

If you do not receive all pages, or have any problems with receiving, please call: 405-235-7700.

THANK YOU

COMMENTS: Pursuant to our conversation this morning, attached is our 02-28-01 Response to Office Action, postcard and Express Mail Receipt regarding the above-referenced Mark. Thank you for your attention to this matter.

Kathy Stanka

LONE STAR

TRAMII GENERAL QUERY AS OF: 07/26/01 13:08:35

SERIAL NUMBER: 75883253
REG. NUMBER: 0000000
REGISTER: PRINCIPAL
FILED USE: YES
FILED ITU: NO
FILED 44D: NO
FILED 44E: NO

FILING DATE: 12/29/1999
REG. DATE:
MARK TYPE: TRADEMARK
CURRENTLY USE: YES
CURRENTLY ITU: NO
CURRENTLY 44D: NO
CURRENTLY 44E: NO

EXAMINER: 75572-RAJU, RADHIKA
LO ASSIGNED: 109
LOCATION: 900-FILE REPOSITORY (FRANCONIA)
DATE IN LOC: 07/24/2001
CHRG TO LOC: NONE
CHRG TO: NONE
STATUS: 602 - ABANDONED - FAILURE TO RESPOND
STATUS DATE: 06/29/2001
A/R EXAMINER: NO A/R EXAMINER ASSIGNED

EXMR LO: 109

PUB DATE:
SECTION 8: NO
RENEWAL FILED: NO
CLASSES ACTIVE: 01

DATE ABANDONED: 03/01/2001
SECTION 15: NO
RENEWAL DATE:

DATE CANCELLED:
ASSIGNMENT: NO
DATE AMENDED REG:

MARK: LONE STAR

CURRENT OWNER INFORMATION

PARTY TYPE: 10-ORIGINAL APPLICANT - FIRST NAME
NAME: Lone Star Steakhouse & Saloon, Inc.
ADDRESS: 224 E. Douglas, Suite 700
WICHITA KANSAS 67202
ENTITY: 03-CORPORATION
CITIZENSHIP: DELAWARE

GOODS AND SERVICES

FOR: Clothing, namely T-shirts, men's and women's sport shirts, sweat shirts, polo shirts and caps
INT. CLASS 025 (U.S. CLASSES 022 AND 039)
FIRST USE 10/12/1989 USE IN COMMERCE 10/12/1989

MISCELLANEOUS INFORMATION / STATEMENTS

SECTION 2F: NO

SECTION 2F IN PART: NO

OWNER OF US REG NOS: 1155907 1731247 2226931 2229771
AND OTHERS

PROSECUTION HISTORY

DATE	ENT CD	ENT TYPE	DESCRIPTION	ENT NUM	PRCD NUM
06/29/01	ABN2	O	ABANDONMENT - FAILURE TO RESPOND	005	000000
08/29/00	CNRT	F	NON-FINAL ACTION MAILED	004	000000
08/28/00	DOCK	D	ASSIGNED TO EXAMINER	003	075572
06/09/00	DOCK	D	ASSIGNED TO EXAMINER	002	067348

Serial Number: 75883253

06/07/00 DOCK D ASSIGNED TO EXAMINER

001

066593

CORRESPONDENCE

ATTORNEY: Joseph J. Ferretti
ATTORNEY DOCKET NUMBER: 22861 (21362)
CORRESPONDENCE ADDRESS: JOSEPH J. FERRETTI
CROWE & DUNLEVY
1800 MID-AMERICA TOWER
20 NORTH BROADWAY, SUITE 1800
OKLAHOMA CITY, OK 73102-8273

OTHER INFORMATION

MARK DRAWING CD: 1-TYPESET WORD(S)/LETTER(S)/NUMBER(S)
SECTION 8 IN PART: NO
REPub SEC 12C: NO PUB DATE 12C:
CHANGE IN REGISTRATION: NO
TTAB DECISION: NO
LOST CASE: NO

TRADE MARK EXAMINATION WORKSHEET

☒ AMENDMENT STAGE

☒ NO CHANGE

☐ PUBLICATION/REGISTRATION STAGE

Name: Kathleen Minnehan L.O. 109 Date 04-10-01

Serial No. 75-883253

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

Legal Instrument Examiner (LIE)

	Amended	Data Element
Class Data	<input type="checkbox"/>	Prime/International Class <input type="checkbox"/> Goods and Services
	<input type="checkbox"/>	First Use Date <input type="checkbox"/> First Use in Commerce Date
	<input type="checkbox"/>	In Another Form <input type="checkbox"/> Certification
	<input type="checkbox"/>	1b
Mark Data	<input type="checkbox"/>	Word Mark <input type="checkbox"/> Pseudo Mark
	<input type="checkbox"/>	Mark Drawing Code <input type="checkbox"/> Design Search Code
	<input type="checkbox"/>	Sizing/Lining Code
Misc. Mark Data	<input type="checkbox"/>	Mark Description <input type="checkbox"/> Disclaimer
	<input type="checkbox"/>	Lining/Stippling <input type="checkbox"/> Name/Portrait/Consent
	<input type="checkbox"/>	Translation
Section 2(f)	<input type="checkbox"/>	Section 2(f) Entire Mark
	<input type="checkbox"/>	Section 2(f) Limitation Statement <input type="checkbox"/> Section 2(f) in Part
	<input type="checkbox"/>	Amended Register <input type="checkbox"/> Amended Register Date
Foreign Reg. Data	<input type="checkbox"/>	Foreign Country <input type="checkbox"/> 44(d)
	<input type="checkbox"/>	Foreign Application Number <input type="checkbox"/> Foreign Application Filing Date
	<input type="checkbox"/>	Foreign Registration Number <input type="checkbox"/> Foreign Registration Date
	<input type="checkbox"/>	Foreign Registration Expiration Date <input type="checkbox"/> Foreign Renewal Reg. Number
	<input type="checkbox"/>	Foreign Reg. Renewal Expiration Date <input type="checkbox"/> Foreign Renewal Reg. Date
Owner Data	<input type="checkbox"/>	Owner Name <input type="checkbox"/> DBA/AKA/TA
	<input type="checkbox"/>	Address 1 <input type="checkbox"/> Address 2
	<input type="checkbox"/>	City <input type="checkbox"/> State
	<input type="checkbox"/>	Zip Code
	<input type="checkbox"/>	Citizenship <input type="checkbox"/> Entity
	<input type="checkbox"/>	Entity Statement <input type="checkbox"/> Composed of
	<input type="checkbox"/>	Assignment(s)/Name Change
	<input type="checkbox"/>	Amendment/Renewal <input type="checkbox"/> Correction
	<input type="checkbox"/>	Concurrent Use <input type="checkbox"/> Restriction
	<input type="checkbox"/>	Interference Statement
Prior U.S. Reg.	<input type="checkbox"/>	Prior Registration
Correspondence	<input type="checkbox"/>	Attorney <input type="checkbox"/> Domestic Representative
	<input type="checkbox"/>	Attorney Docket Number
	<input type="checkbox"/>	Correspondence Firm Name/Address

I certify that all corrections have been entered in accordance with text editing guidelines.

Kathleen M Minnehan

LIE

04-10-01

DATE

Other: Proposed Untimely

Crowe & Dunlevy

A PROFESSIONAL CORPORATION

ATTORNEYS AND COUNSELORS AT LAW
1800 MID-AMERICA TOWER
20 NORTH BROADWAY
OKLAHOMA CITY, OKLAHOMA 73102-8273
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NORMAN, OKLAHOMA 73072-6705
(405) 321-7317
FAX (405) 360-4002

JOSEPH J. FERRETTI
DIRECT LINE (405) 235-7744
DIRECT FAX (405) 272-5256

E-MAIL ferretti@crowedunlevy.com

February 28, 2001

2

Via Express Mail EL638306423US

Box RESPONSES - NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Response to the Office Action Mailed August 29, 2000
Applicant: Lone Star Steakhouse & Saloon, Inc.
Serial No. 75/883253
Trademark: LONE STAR
Filed: December 29, 1999

Dear Commissioner:

Enclosed please find the following documents relating to the referenced mark:

- Response to the Office Action Mailed August 28, 2000; and
- an acknowledgment postcard.

Please acknowledge your receipt of these documents by placing your receipt stamp on the enclosed postcard and returning it to us. The above documents are being sent by Express Mail Receipt No. EL638306423US.

It is believed that no fees are required in connection with this Response; however, should fees be required, you are hereby authorized to charge same to Deposit Account No. 13-0110.

Sincerely,



Joseph J. Ferretti
For the Firm

JJF:kay
Enclosures

cc: Gerald Aaron

CHAMBERS
25-01-V-L-100-002
101-000000-0000

EXPRESS MAIL RECEIPT NO. EL638306423US
DEPOSITED ON February 28, 2001

TRADEMARK
22861

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	LONE STAR STEAKHOUSE)
	& SALOON, INC.)
) Examining Attorney Radhika Raju
) Law Office: 109
Serial No.:	75/883253)
) Response to Office Action
Filed:	December 29, 1999) Mailed: 08/29/00
)
Mark:	LONE STAR)

BOX RESPONSES - NO FEE
Law Office 101
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

**APPLICANT'S RESPONSE TO
OFFICE ACTION MAILED AUGUST 29, 2000**

Applicant, Lone Star Steakhouse & Saloon, Inc., herein responds to the Office Action dated August 29, 2000. Applicant respectfully submits that Applicant's Mark is entitled to registration because the PTO has failed to demonstrate that Applicant's Mark is either primarily geographically deceptively misdescriptive or geographically descriptive.

I. Applicant's Mark Is Not Primarily Geographically Deceptively Misdescriptive.

Applicant respectfully submits that the Examiner has not presented a *prima facie* case establishing that Applicant's Mark is primarily geographically deceptively misdescriptive.

To establish a *prima facie* case for refusal to register a Mark as primarily geographically deceptively misdescriptive under §2(e)(3), the Examining must establish the following:

- (1) the primary significance of the Mark is geographic;
- (2) purchasers would be likely to think that the goods originate in the geographic place identified in the Mark, *i.e.*, purchasers would make a goods/place association; **and**
- (3) the goods do not originate in the place identified in the Mark.

TMEP §1210.06. Further, to satisfy its *prima facie* burden for refusing to register the Mark, all three elements must be met.

With regard to the first element, Applicant respectfully submits that the Examiner has not established that the "primarily" significance of the proposed Mark, LONE STAR, is that of geographic location. Although dictionary definitions may be useful to glean the "primary" significance of a Mark, the Examiner did not provide the dictionary definition of "LONE STAR." Rather, the Examiner cited to the definition of "TEXAS" which simply states as follows:

"Nickname: Lone Star State."

See attachment to 8/29/00 Office Action.

Reliance upon the above definition fails to satisfy the Examiner's burden for two reasons. One, this definition does not establish that the *primary* significance of LONE STAR is that of geographic location. Rather, this definition simply notes – *under the definition of TEXAS* – that "LONE STAR STATE" is a nickname for Texas. Because this is not the definition for LONE STAR, one cannot determine whether the primary, the secondary or even the tertiary significance of "LONE STAR" is that of geographic location; one can only determine that *one of the significances* (of LONE STAR STATE) relates to TEXAS.

Two, the dictionary indicates that the nickname for TEXAS is the "LONE STAR STATE." Applicant's Mark, however, is not "LONE STAR STATE." Rather, Applicant's Mark is simply "LONE STAR." Were Applicant using LONE STAR STATE as its Mark, there may be grounds for concluding a geographic significance, i.e. Texas, as the dictionary suggests. However, Applicant is simply using the Mark LONE STAR, *without the geographic reference to "STATE."* Thus, on its face the cited dictionary reference does not support a finding that the significance (which must be "primary") of Applicant's Mark is that of geographic location. For these two reasons, Applicant respectfully submits that the first element has not been satisfied.

With regard to the second element – the establishment of a goods/place association – the record is bare of any such evidence. A refusal under §2(e)(3) requires the Examiner to submit evidence establishing a goods/place association, such that the public is likely to believe that the goods originate in the place identified in the Mark. TMEP§1210.04. Because no goods/place association has been made, the *prima facie* case has not been established and there can be no finding that Applicant's Mark is primarily geographically deceptively misdescriptive. *See, In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (C.C.P.A. 1982) (NANTUCKET held not primarily geographically deceptively misdescriptive of men's shirts originating in North Carolina because of no persuasive evidence of a goods/place association).

Thus, while the PTO must establish all three elements to satisfy its *prima facie* case to refuse registration, Applicant respectfully submits that two of the three elements are lacking. The first element has not been satisfied as there has been no showing of "primary" significance. The second element is lacking because there is no evidence in the record supporting a goods/place association.

II The Mark is Not Geographically Descriptive.

To establish a *prima facie* case for refusal to register a Mark as geographically descriptive under §2(e)(2), the Examining must establish each the following elements:

- (1) the primary significance of the Mark is geographic;
- (2) purchasers would be likely to think that the goods originate in the geographic place identified in the Mark, *i.e.*, purchasers would make a goods/place association; **and**
- (3) the Mark identifies the geographic origin of the goods.

TMEP §1210.05.

Applicant respectfully submits that the Examiner has similarly failed to establish its *prima facie* case that Applicant's Mark is geographically descriptive. For the same reasons identified above, Applicant submits that the first two elements have not been established.

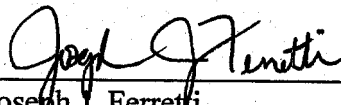
First, there has been no showing that 'a' significance of the Mark LONE STAR is geographic – the test, however, requires "primary" significance. While 'a' showing has been made concerning LONE STAR STATE, this is not Applicant's Mark – Applicant does not include the geographic reference to "STATE" in its Mark. Second, there is no evidence in the record establishing a goods/place association. TMEP §1210.04. *See also, In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 849-850 (TTAB 1982) (goods/place association must be established by examiner if there is question as to whether the primary significance is geographic).

Thus, Applicant's Mark is not geographically descriptive, and therefore, registration is proper.

CONCLUSION

Thus, based on the above, Applicant respectfully submits that registration of Applicant's Mark is proper.

Respectfully submitted,



Joseph J. Ferretti

CROWE & DUNLEVY, P.C.

1800 Mid-America Tower

20 N. Broadway

Oklahoma City, Oklahoma 73102-8273

Telephone No.: (405) 235-7744

Fax No.: (405) 272-5256

Attorney for Applicant

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. 75/883253 Lone Star Steakhouse & Saloon, Inc.		APPLICANT Lone Star Steakhouse & Saloon, Inc.		PAPER NO. 	
MARK LONE STAR		ADDRESS JOSEPH J. FERRETTI CROWE & DUNLEVY 1800 MID-AMERICA TOWER 20 NORTH BROADWAY, SUITE 1800 OKLAHOMA CITY, OK 73102-8273		ADDRESS: Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 www.uspto.gov	
FORM PTO-1525 (5-90)		U.S. DEPT. OF COMM. PAT. & TM OFFICE		ACTION NO. 01	
				MAILING DATE 08/29/00	
				REF. NO. 22861 (21362	
If no fees are enclosed, the address should include the words "Box Responses - No Fee."					
Please provide in all correspondence:					
1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.					

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/883253

The assigned examining attorney has reviewed the referenced application and determined the following.

Search Clause

The examining attorney has searched the Office records and has found no similar registered mark which bars registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01. Please note that the examining attorney has found potentially conflicting pending applications.

The examining attorney encloses information regarding pending Application Serial Nos. 75/273718 and 75/775808. The filing dates of the referenced applications precede the applicant's filing date. There may be a likelihood of confusion between the applicant's mark and the referenced marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). If one or more of the referenced applications matures into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. Section 2.83; TMEP section 1208.01.

Refusal-Geographically Deceptively Misdescriptive

The applicant has applied to register the mark LONE STAR for various items of clothing. The applicant is located in KANSAS. The examining attorney refuses registration on the Principal Register because the mark is primarily geographically deceptively Misdescriptive. Trademark Act Section 2(e)(3), 15 U.S.C. Section 1052(e)(3); TMEP section 1210.06.

The primary significance of the term LONE STAR is geographic. LONE STAR State is the nickname of Texas. See the attached excerpt from the Merriam Webster's Geographical Dictionary. The applicant's services do not originate from this place. The mark is geographically deceptively misdescriptive because the public would believe that applicant's goods come from TEXAS. *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

NOTE: A mark which, when used on or in connection with the applicant's goods or services, is primarily geographically deceptively misdescriptive of them, is registrable upon a showing of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), **only if it became distinctive of the goods or services in commerce before December 8, 1993**, the date of the enactment of the North American Free Trade Agreement Implementation Act, Public Law 103-182, 107 Stat. 2057. Similarly, such a mark, capable of distinguishing the applicant's goods or services, may be registered on the Supplemental Register **only if it has been in lawful use in commerce by the owner since before December 8, 1993**.

The applicant should also note the following additional ground for refusal.

Geographically Descriptive

If the applicant's goods come from Texas, the examining attorney refuses registration on the Principal Register because the mark is primarily geographically descriptive of the applicant's goods. Trademark Act Section 2(e)(2), 15 U.S.C. Section 1052(e)(2); TMEP section 1210.05.

The primary significance of the term "LONE STAR" is geographic (see discussion above), and applicant's goods come from the geographical place named in the mark. Therefore, a public association of the goods with the place is presumed. *In re California Pizza Kitchen*, 10 USPQ2d 1704 (TTAB 1989); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

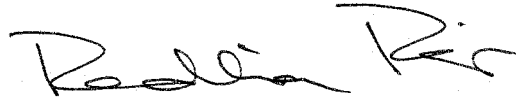
The examining attorney has determined that the primary significance of the term "LONE STAR" is geographic. The fact that a term may have other meanings does not necessarily negate the basis for refusal. *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986); *In re Cookie Kitchen, Inc.*, 228 USPQ 873 (TTAB 1986).

Response

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

Closing

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

A handwritten signature in black ink, appearing to read "Radhika Raju", with a stylized flourish at the end.

Radhika Raju
Trademark Attorney
Law Office 109
(703) 308-9109 ext. 196
radhika.raju@uspto.gov



Mark

LONE STAR UNIFORMS

Pseudo Mark

LONE STAR UNIFORMS

Goods and Services

IC 025. US 022 039. G & S: clothing, namely, uniforms

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

010105 240325 270305

Serial Number

75273718

Filing Date

April 14, 1997

Filed ITU

FILED AS ITU

Publication for Opposition Date

November 9, 1999

Owner Name and Address

*** User: rraju *** Serial Number: 75273718 ***

(APPLICANT) Blauer Manufacturing Company, Inc. CORPORATION MASSACHUSETTS
20 Aberdeen Street Boston MASSACHUSETTS 02215

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "UNIFORMS" APART FROM THE
MARK AS SHOWN

Description of Mark

The mark is lined for the color gray.

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

LONE STAR CLASSIC

Mark
LONE STAR CLASSIC

Goods and Services
IC 025. US 022 039. G & S: Clothing, namely t-shirts, caps shorts and polo shirts. FIRST USE: 19920401. FIRST USE IN COMMERCE: 19920401

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75775808

Filing Date
August 6, 1999

Filed ITU
FILED AS ITU

Owner Name and Address
(APPLICANT) Junior Volleyball Association of Austin NON-PROFIT CORPORATION TEXAS 2026 Guadalupe Street. Suite 302 Austin TEXAS 78705

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CLASSIC" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL-2(F)

Live Dead Indicator
LIVE

Merriam-Webster's Geographical Dictionary

THIRD EDITION



MERRIAM-WEBSTER, INCORPORATED, *Publishers*
Springfield, Massachusetts, U.S.A.

EXPRESS MAIL RECEIPT NO. EJ823466035US
DEPOSITED ON DECEMBER 29, 1999

TRADEMARK
Dkt. 22861

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICATION FOR ACTUAL USE TRADEMARK REGISTRATION**

Mark: LONE STAR

Class: International 25

Applicant: Lone Star Steakhouse & Saloon, Inc.,
a Delaware Corporation

Applicant's Address: 224 E. Douglas, Suite 700, Wichita, KS 67202

BOX NEW APP FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

The above-identified Applicant hereby requests that the mark shown in the accompanying drawing be registered in the United States Patent and Trademark office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051 *et seq.*, as amended) for the following goods:

Clothing, namely T-shirts, men's and women's sport shirts, sweat shirts, polo shirts and caps in International Class 25.

Applicant is using the mark in commerce on or in connection with the identified goods.

The mark was first used on the services at least as early as October 12, 1989, was first so used in interstate commerce at least as early as October 12, 1989, and is now in use in such commerce (15 U.S.C. §1051(a), as amended).

Applicant is also the owner of the following Marks:

Reg. Nos: 2,229,771 2,226,931 1,731,247 1,155,907

3 Files PE/157

The mark is used on and in connection with Applicant's clothing, such as in advertising and promotional materials, and other means common in the trade, by placing it on the goods, displays associated with the goods, and tags or labels affixed to the goods. One (1) specimen showing the mark as actually used in commerce is presented herewith.

DECLARATION

I, Gerald T. Aaron, declare that I am Senior Vice President of applicant corporation, Lone Star Steakhouse & Saloon, Inc., and am authorized to make this declaration on behalf of said corporation; that I believe said corporation to be the owner of the trademark sought to be registered; that to the best of my knowledge and belief no other person, firm, corporation or association has the right to use said mark in commerce, either in identical form or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive; that all statements made herein of my own knowledge are true; that all statements made herein on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application and any registration resulting therefrom.

Signed this 17 day of December, 1999.

LONE STAR STEAKHOUSE & SALOON, INC.,
a Delaware corporation, Applicant,

By Gerald T. Aaron
Gerald T. Aaron, Senior Vice President


POWER OF ATTORNEY

Lone Star Steakhouse & Saloon, Inc., Applicant, hereby appoints Joseph J. Ferretti, Bill D. McCarthy, Registration No. 26,772, Phillip L. Free, Jr., Registration No. 38,143, Randall K. McCarthy, Registration No. 39,297, and Daniel S. Hodgins, Registration No. 31,026, all of Crowe & Dunlevy, 1800 Mid-America Tower, 20 North Broadway, Suite 1800, Oklahoma City, OK 73102-8273, to prosecute the application to register, to transact this business in the United States Patent and Trademark Office in connection therewith, and to receive the Certificate of Registration.

Please address all correspondence and telephone calls to:

Joseph J. Ferretti, Esq.
Crowe & Dunlevy
1800 Mid-America Tower
20 North Broadway, Suite 1800
Oklahoma City, OK 73102-8273
Telephone: (405) 235-7744
FAX: (405) 272-5256

Respectfully submitted,

By 
Gerald T. Aaron, Senior Vice President

Crowe & Dunlevy

A PROFESSIONAL CORPORATION
ATTORNEYS AND COUNSELORS AT LAW
1800 MID-AMERICA TOWER
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INTERNET ferrettj@crowedunlevy.com
X.400 /C=us/A=attmail/O=attmail/DDA.ID
=crowedun!ferrettj

December 29, 1999

BOX NEW APP FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Application for Actual Use Trademark Registration
Applicant: Lone Star Steakhouse & Saloon, Inc.
Mark: LONE STAR
Docket: 22861 (21362-00001)

Dear Assistant Commissioner:

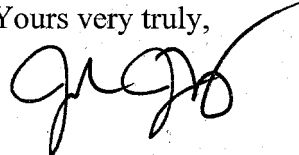
Enclosed herewith for filing is an APPLICATION FOR ACTUAL USE TRADEMARK REGISTRATION with its signed Declaration, Power of Attorney, Drawing and Specimen attached. Also enclosed is our check covering the filing fee in the amount of \$245.00 and an acknowledgment postcard.

Should additional fees be required, you are hereby authorized to charge same to Deposit Account 13-0110.

The enclosed papers are being forwarded by Express Mail Receipt No. EJ823466035US on December 29, 1999.

Please advise if you require anything further.

Yours very truly,



Joseph J. Ferretti
For the Firm

JJF/BSC/bc
Enclosures

cc: Gerald T. Aaron

75883253

TRADEMARK APPLICATION SERIAL NO. _____

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

01/06/2000 EWINSTON 00000083 75883253

01 FC:361

245.00 OP



CROWE & DUNLEVY
ATTORNEYS AND COUNSELORS AT LAW
1900 North Broadway, Suite 1800
Oklahoma City, Oklahoma 73102-8273

JOSEPH J. FERRETTI
Direct Tel: 405.235-7744
Direct Fax: 405.272.5256

ferretti@crowedunlevy.com

September 18, 2003

Express Mail Receipt No. EV085805973US

Deposited on September 18, 2003

Box RESPONSES - NO FEE

Law Office 101

Commissioner for Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3513

Re: Applicant's Response to the Office Action Mailed March 18, 2003

Applicant: Lone Star Steakhouse & Saloon, Inc.

Serial No. 75/883,253

Trademark: LONE STAR

Filed: December 29, 1999

Dear Commissioner:

Enclosed please find the following documents relating to the above-referenced mark:

1. Applicant's Response to the Office Action Mailed March 18, 2003, and
2. An acknowledgment postcard.

Please acknowledge your receipt of these documents by placing your receipt stamp on the enclosed postcard and returning it to us. The above documents are being sent by Express Mail Receipt No. EV085805973US on Thursday, September 18, 2003.

It is believed that no fees are required in connection with this Response; however, should fees be required, you are hereby authorized to charge same to Deposit Account No. 13-0110.

Sincerely,



09-22-2003

U.S. Patent & TMOs/TM Mail Rcpt Dt. #39

Joseph J. Ferretti
For the Firm

JJF/kas

Enclosures

cc: Lone Star Steakhouse & Saloon, Inc.

1282328.1

OKLAHOMA CITY
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**EXPRESS MAIL RECEIPT NO. EV085805973US
DEPOSITED ON SEPTEMBER 18, 2003**

**SERVICE MARK
Dkt. TM1325US25**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	LONE STAR STEAKHOUSE)	
	& SALOON, INC.)	
)	Examining Attorney Katherine Stoides
)	Law Office: 101
Serial No.:	75/883,253)	
)	Response to Office Action
Filed:	December 29, 1999)	Mailed: 03/18/03
)	
Mark:	LONE STAR)	

BOX RESPONSES - NO FEE
Law Office 101
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

**APPLICANT'S RESPONSE TO
OFFICE ACTION MAILED MARCH 18, 2003**

This is in response to the second Office Action mailed March 18, 2003. Please find the enclosed remarks in response to the second Office Action.

REMARKS

I. Refusal of Registration Based on Likelihood of Confusion

The present trademark application was filed December 29, 1999. In the second Office Action mailed March 18, 2003, the Examining Attorney refused registration of the Applicant's mark LONE STAR on the Principal Register on the basis that the applicant's mark is likely to be confused with the mark LONE STAR CLASSIC, registration number 2,589,026. The applicant responds to the refusal to register and respectfully submits that registration is proper.

As indicated by the Examining Attorney, the Court in *In re DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) listed factors to be considered in determining whether there is a likelihood of confusion. The Applicant submits that consideration of the *DuPont* factors suggests that there is no likelihood of confusion between the registrant's and the applicant's marks.

Although the Office Action cites the *DuPont* factors, only two of the factors appear to have been considered by the Examining Attorney. These factors, the similarity of the marks and the similarities of the goods, have been used to come to a conclusion that there is a likelihood of confusion between the marks at issue. However, it is respectfully submitted that an examination of all the *DuPont* factors demonstrates that there is no likelihood of confusion.

In addition, as will be highlighted below in the discussion of the *DuPont* factors, in 2001, Applicant and Registrant entered into an agreement (the "Agreement") whereby the parties agreed to limitations upon use of their respective Marks to ensure that there would, in fact, be no likelihood of confusion. (See Exhibit "A"). Applicant submits that based upon the limitations prescribed in the agreement, that there is no likelihood of confusion – and there has been no actual confusion as well.

A. Channels of Trade

One of the *DuPont* factors, namely the similarity of established, likely to continue trade channels, supports a finding of no likelihood of confusion. *Id.* Dissimilarity in trade channels negates that confusion is not likely. The Applicant sells its goods from stores in its chain of restaurants, for sale on the premises. Products of the Registrant will not be on sale in Applicant's restaurant – or in any restaurant pursuant to the Agreement – and therefore there is no remote possibility of similar trade channels. Since the Applicant's goods are limited to sales in association with its own restaurants, the dissimilar trade channels preclude a finding of likelihood of confusion.

B. Conditions at Purchase

In a related *DuPont* factor, the conditions under which and buyers to whom sales are made is considered. *Id.* This factor considers the mind-set of buyers and includes the care exercised by buyers. Buyers purchasing the goods of the Applicant will be in Applicant's restaurants (which share the same name as that of the Applicant's mark). Barring exceptional circumstances, buyers will know that they are in the Applicant's restaurants and are not likely to confuse the goods of the Applicant with any other source. As stated above, Registrant's goods will never be sold in restaurants or similar type establishments (See Agreement).

C. Fame of Prior Mark

Another *DuPont* factor considers the fame of the prior mark. *Id.* A prior mark that is not particularly famous is less likely to be confused with another mark. Although the Registrant's mark has apparently enjoyed over a decade of use and is likely known in circles familiar with junior volleyball in which it presides, it is unlikely that the Registrant's mark has achieved the level of fame that would cause confusion between the Registrant's and the Applicant's marks. Also, since Applicant's goods are sold in its restaurants and not at volleyball events, this factor also demonstrates no likelihood of confusion.

D. Actual Confusion

DuPont also considers evidence of actual confusion during the time of concurrent use. *Id.* A lack of evidence of actual confusion also suggests that a likelihood of confusion does not exist. In the present case, both the Registrant and the Applicant claim over a decade of use, yet the Office Action does not present a single incident of actual confusion between the marks. Likewise, the Applicant has been presented with no incident of actual confusion, another factor that suggests confusion is not likely. In fact, the Agreement sets forth specific limitations to prevent actual confusion from occurring.

E. Market Interface

The market interface between the Registrant and Applicant is also considered by *DuPont*. *Id.* The two parties have no desire to cause confusion and are in agreement as to the separate and distinct nature of each others' uses. Additionally, the two parties have agreed in writing, *inter alia*, to pursue separate marketing channels. (See the Agreement.)

F. Right to Exclude

DuPont also considers the extent to which the Applicant has a right to exclude others from use of its mark on its goods. *Id.* A greater right to exclude on the part of the Applicant falls in favor of no likelihood of confusion. The Applicant has been using the proposed mark since the late 1980s for the listed goods and has several other registered marks that use the "Lone Star" Mark. Among these registered marks are registration numbers 1155907, 1731247, 2226931, 2229771, and others. Federal and common law rights have been developed by the Applicant in the mark at issue, and this extent of rights again suggests that a likelihood of confusion does not exist.

G. Potential Confusion

The *DuPont* Court also addressed whether the extent of potential confusion is de minimis or substantial. *Id.* Obviously, the less potential confusion between the marks suggests less of a likelihood of confusion. As suggested by the factors addressed above, any confusion between the goods represented by the marks at issue would be cursory, and confusion between the marks is simply not likely – especially considering the precautions taken by Applicant and Registrant pursuant to the Agreement.

H. Conclusion

The weight given to particular *DuPont* factors may differ among those determining a likelihood of confusion. *Id.* at 567. However, in full recognition of these differences the Applicant submits that the dissimilarity of established, likely to continue trade channels should carry substantial weight. This is especially in light of the precautions taken by Applicant and Registrant in the Agreement to ensure that there is no likely, nor has there been any actual, confusion.

Similarly, none of the factors cited above indicate that confusion is likely between the marks at issue, as the sheer number of factors support registration of the present mark. The Applicant respectfully requests that the refusal to register be withdrawn and the application be approved for publication.

II. Informality Regarding Geographic Origin

The Examiner has requested that Applicant identify the geographic origin of the goods related to the application. Applicant's goods will be sold in its restaurants in the following states, Alabama, Alaska, Arizona, Arkansas, California, Colorado, Delaware, Florida, Georgia, Idaho, Illinois, Indiana, Iowa, Kansas, Kentucky, Louisiana, Maine, Maryland, Massachusetts, Michigan, Mississippi, Missouri, Nebraska, Nevada, New Jersey, New Mexico, New York, North Carolina, North Dakota, Ohio, Oklahoma, Pennsylvania, Rhode Island, South Carolina, South Dakota, Tennessee, Utah, Virginia, West Virginia, Wisconsin, as more particularly identified on its website at: www.lonestarsteakhouse.com/LocationSearch.asp.

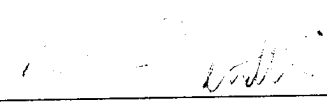
III. Continuance of Sections 2(e)(2) and 2(e)(3).

As the Examiner has continued the refusals relating to Sections 2(e)(2) and 2(e)(3), Applicant herein re-incorporates its response previously filed with the PTO on February 28, 2001 and reserves the right to further address this issue to the extent the Examiner raises the issue in the future.

IV. Conclusion

For the aforementioned reasons – particularly because Applicant and the cited Registrant have entered into the Agreement which takes measures to ensure that there is no likelihood of confusion between their respective Marks – Applicant respectfully submits that registration of Applicant's Mark is proper.

Respectfully submitted,



Joseph J. Ferretti
CROWE & DUNLEVY, P.C.
1800 Mid-America Tower
20 N. Broadway
Oklahoma City, Oklahoma 73102-8273
Telephone No.: (405) 235-7744
Fax No.: (405) 272-5256

Attorney for Applicant

SETTLEMENT AGREEMENT

This Agreement is made by and between Lone Star Steakhouse & Saloon, Inc. ("LSS&S"), a Delaware corporation with its principal place of business in Wichita, Kansas, and Junior Volleyball Association of Austin ("JVAA"), a Texas non-profit corporation with offices in Austin, Texas. This Agreement is effective as of the date it has been signed by the parties.

WHEREAS, LSS&S is engaged, *inter alia*, in the business of providing restaurant services and selling various clothing items in interstate commerce and in connection therewith has used the service marks and trademarks LONE STAR, LONE STAR CAFE and LONE STAR STEAKHOUSE & SALOON;

WHEREAS, LSS&S is the owner of the United States Trademark and Service Mark Registrations and applications for Registration listed in the attached **Exhibit A** for marks containing or comprising the term "LONE STAR" as used in connection with both restaurant services and clothing, which trademarks and service marks are still in use and which registrations are valid and in full force and effect;

WHEREAS, JVAA is engaged, *inter alia*, in the business of organizing and sponsoring volley ball tournaments in Texas under the service mark LONE STAR CLASSIC, and in connection therewith is has sold and sells clothing under the trademark LONE STAR CLASSIC;

WHEREAS, JVAA has filed use-based Applications to register the service mark and trademark LONE STAR CLASSIC, for entertainment services in the nature of

EXHIBIT A

volleyball tournaments, in International Classes 16, 25, and 41 as set forth fully in the attached **Exhibit B**;

WHEREAS, the parties desire to avoid any conflict or confusion that might arise from their concurrent use and registration of their respective marks;

NOW, THEREFORE, in consideration of the mutual promises, releases, and covenants hereinafter set forth, the parties agree as follows:

1. JVAA acknowledges that LSS&S's above-identified trademarks and service marks are valid; acknowledges that LSS&S's above-identified trademark and service mark registrations and applications for registration are valid; and agrees not to challenge or object to LSS&S's use or registration of the marks LONE STAR, LONE STAR CAFE, LONE STAR STEAKHOUSE AND SALOON, LONE STAR TAKE AWAY, LONE STAR STATE OF MIND, or any other mark containing or comprising the term "LONE STAR" and used or proposed for use in connection with restaurant and bar services or clothing.

2. JVAA may continue to use and seek to register the mark LONE CLASSIC in connection with its services and on clothing associated therewith and distributed directly by JVAA at volleyball tournaments, over the Internet or through the mail, or distributed through retail sporting goods or clothing stores. JVAA, however, agrees never to use the mark LONE STAR CLASSIC, or any other mark containing or comprising the terms "LONE STAR" or "LONESTAR" on or in connection with clothing that is distributed to or through, or in association with, restaurants, bars, or other establishments associated with the sale of foods or beverages.

3. JVAA agrees never to seek to register the mark LONE STAR CLASSIC, or any other mark containing or comprising the terms "LONE STAR" or "LONESTAR" on

or in connection with restaurant services. JVAA further agrees never to use or seek to register any mark containing or comprising the words "LONESTAR" or "LONE STAR" in combination with the trade name or service mark of any restaurant, bar, or other establishment associated with the sale of food or beverages, or the words "saloon", "steakhouse", "steaks", or "cafe", in connection with any goods or services.

4. Provided that JVAA complies with the restrictions set forth herein, LSS&S agrees not to challenge JVAA's continued use of the mark LONE STAR CLASSIC or any other mark containing or comprising the words "LONE STAR" on or in connection with the goods and services set forth in **Exhibit B**.

5. LSS&S further agrees not to use or seek to register any trademark or service mark containing or comprising the words "LONE STAR" on or in connection with organizing and conducting volleyball games, volleyball competitions, volleyball sporting events, or volleyball tournaments, or selling or offering for sale volleyball-related sporting equipment.

6. This Agreement and **Exhibits A and B** attached hereto constitute the entire agreement between the parties and may not be changed orally, but only by an agreement in writing signed by the party against whom enforcement is sought.

7. This Agreement shall be binding upon and shall inure to the benefit of the parties, their successors, assigns, subsidiaries, licensees, affiliated companies and all those in active concert or participation with them.

ACCEPTED AND AGREED:

LONE STAR STEAKHOUSE
& SALOON, INC.

Dated: 4-23-01 By Gerald T. Aaron
Name: Gerald T. Aaron
Its: Sr. Vice President - Counsel

JUNIOR VOLLEYBALL ASSOCIATION OF AUSTIN

Dated: _____ By [Signature]
Name: _____
Its: DIRECTOR

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 75/883253

APPLICANT: Lone Star Steakhouse & Saloon, Inc.

CORRESPONDENT ADDRESS:

JOSEPH J. FERRETTI
CROWE & DUNLEVY
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OKLAHOMA CITY, OK 73102-8273

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ecom110@uspto.gov

MARK: LONE STAR

CORRESPONDENT'S REFERENCE/DOCKET NO: 22861 (21362

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 75/883253

The Office has reassigned this application to the undersigned examining attorney.

As U.S. Application Serial No. 75-775808 has matured into U.S. Registration No. 2589026, action on this application is resumed.

SECTION 2(d) REFUSAL -- Likelihood Of Confusion

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on the identified goods, is likely to be confused with the registered mark in U.S. Registration No. 2589026. TMEP section 1207. See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood

of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. In *re* E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. In *re* August Storck KG, 218 USPQ 823 (TTAB 1983); In *re* International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The examining attorney has determined that contemporaneous use of the marks LONE STAR and LONE STAR CLASSIC, as applied to clothing, would be likely to cause confusion for the following reasons.

The Court in *In re* E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods.

A. The Marks

The examining attorney must look at the marks in their entirety under Section 2(d). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. In *re* National Data Corp., 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). In *re* J.M. Originals Inc., 6 USPQ2d 1393 (TTAB 1988).

While the examining attorney cannot ignore a disclaimed portion of a mark and must view marks in their entirety, one feature of a mark may be more significant in creating a commercial impression. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). Disclaimed matter is typically less significant or less dominant.

Application of the above standards clearly indicates that the dominant feature of both marks is the same phrase LONE STAR. The addition of the disclaimed, descriptive term CLASSIC is of little, if any, trademark significance. When the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicor Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b).

And finally, if the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980). TMEP §1207.01(b).

B. The Goods

Both parties identify goods that are, in part, identical -- t-shirts, caps and polo shirts. The applicant is advised that the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

C. Conclusion

For the foregoing reasons, the applicant's LONE STAR is refused registration under Section 2(d) of the Trademark Act.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

INFORMALITY

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informality.

Geographic Origin

The applicant must identify the geographic origin of the goods. 37 C.F.R. §2.61(b).

SECTIONS 2(e)(2) and 2(e)(3) REFUSALS – Continued

Pending the applicant's response to the above informality, the refusals under Sections 2(e)(2) and 2(e)(3) are CONTINUED.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Katherine Stoides/
Examining Attorney
Law Office 110

(703) 308-9110 ext.166

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

LONE STAR CLASSIC

Serial Number

75775808

Status

REGISTERED

Word Mark

LONE STAR CLASSIC

Registration Number

2589026

Date Registered

2002/07/02

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Junior Volleyball Association of Austin NON-PROFIT CORPORATION TEXAS
2026 Guadalupe Street, Suite 302 Austin TEXAS 78705

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Clothing,
namely t-shirts, caps shorts, and polo shirts. First Use: 1992/04/01.
First Use In Commerce: 1992/04/01.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CLASSIC" APART FROM
THE MARK AS SHOWN.

Section 2f Statement

2(F) ENTIRE MARK

Filing Date

1999/08/06

Print: Mar 16, 2003

75775808

Examining Attorney
STOIDES, KATHERINE

Attorney of Record
Diana K. Borden



12-29-1999

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #31

APPLICANT: Lone Star Steakhouse & Saloon, Inc.,
a Delaware Corporation

ADDRESS: 224 E. Douglas, Suite 700, Wichita, KS 67202

DATE OF FIRST
USE: October 12, 1989

DATE OF FIRST
USE IN COMMERCE: October 12, 1989

GOODS: Clothing, namely T-shirts, men's and women's sport shirts, sweat
shirts, polo shirts and caps.

LONE STAR

TRADEMARK



75883253

75883253

TRADEMARK APPLICATION SERIAL NO. __

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

01/06/2000 EWINSTON 00000083 75883253

01 FC:361

245.00 OF

Crowe & Dunlevy

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=crowedun@ferretti

December 29, 1999

BOX NEW APP FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Application for Actual Use Trademark Registration
Applicant: Lone Star Steakhouse & Saloon, Inc.
Mark: LONE STAR
Docket: 22861 (21362-00001)

Dear Assistant Commissioner:

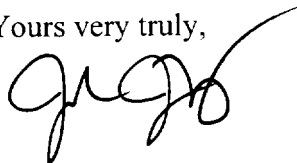
Enclosed herewith for filing is an APPLICATION FOR ACTUAL USE TRADEMARK REGISTRATION with its signed Declaration, Power of Attorney, Drawing and Specimen attached. Also enclosed is our check covering the filing fee in the amount of \$245.00 and an acknowledgment postcard.

Should additional fees be required, you are hereby authorized to charge same to Deposit Account 13-0110.

The enclosed papers are being forwarded by Express Mail Receipt No. EJ823466035US on December 29, 1999.

Please advise if you require anything further.

Yours very truly,



Joseph J. Ferretti
For the Firm

JJF/BSC/bc
Enclosures

cc: Gerald T. Aaron

EXPRESS MAIL RECEIPT NO. EJ823466035US
DEPOSITED ON DECEMBER 29, 1999

TRADEMARK
Dkt. 22861

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICATION FOR ACTUAL USE TRADEMARK REGISTRATION**

Mark: LONE STAR

Class: International 25

Applicant: Lone Star Steakhouse & Saloon, Inc.,
a Delaware Corporation

Applicant's Address: 224 E. Douglas, Suite 700, Wichita, KS 67202

BOX NEW APP FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

The above-identified Applicant hereby requests that the mark shown in the accompanying drawing be registered in the United States Patent and Trademark office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051 *et seq.*, as amended) for the following goods:

Clothing, namely T-shirts, men's and women's sport shirts, sweat shirts, polo shirts and caps in International Class 25.

Applicant is using the mark in commerce on or in connection with the identified goods.

The mark was first used on the services at least as early as October 12, 1989, was first so used in interstate commerce at least as early as October 12, 1989, and is now in use in such commerce (15 U.S.C. §1051(a), as amended).

Applicant is also the owner of the following Marks:

Reg. Nos: 2,229,771 2,226,931 1,731,247 1,155,907

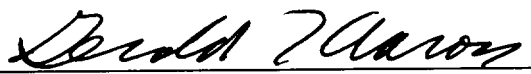
The mark is used on and in connection with Applicant's clothing, such as in advertising and promotional materials, and other means common in the trade, by placing it on the goods, displays associated with the goods, and tags or labels affixed to the goods. One (1) specimen showing the mark as actually used in commerce is presented herewith.

DECLARATION

I, Gerald T. Aaron, declare that I am Senior Vice President of applicant corporation, Lone Star Steakhouse & Saloon, Inc., and am authorized to make this declaration on behalf of said corporation; that I believe said corporation to be the owner of the trademark sought to be registered; that to the best of my knowledge and belief no other person, firm, corporation or association has the right to use said mark in commerce, either in identical form or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive; that all statements made herein of my own knowledge are true; that all statements made herein on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application and any registration resulting therefrom.

Signed this 17 day of December, 1999.

LONE STAR STEAKHOUSE & SALOON, INC.,
a Delaware corporation, Applicant,

By 
Gerald T. Aaron, Senior Vice President

POWER OF ATTORNEY

Lone Star Steakhouse & Saloon, Inc., Applicant, hereby appoints Joseph J. Ferretti, Bill D. McCarthy, Registration No. 26,772, Phillip L. Free, Jr., Registration No. 38,143, Randall K. McCarthy, Registration No. 39,297, and Daniel S. Hodgins, Registration No. 31,026, all of Crowe & Dunlevy, 1800 Mid-America Tower, 20 North Broadway, Suite 1800, Oklahoma City, OK 73102-8273, to prosecute the application to register, to transact this business in the United States Patent and Trademark Office in connection therewith, and to receive the Certificate of Registration.

Please address all correspondence and telephone calls to:

Joseph J. Ferretti, Esq.
Crowe & Dunlevy
1800 Mid-America Tower
20 North Broadway, Suite 1800
Oklahoma City, OK 73102-8273
Telephone: (405) 235-7744
FAX: (405) 272-5256

Respectfully submitted,

By 
Gerald T. Aaron, Senior Vice President



12-29-1999

U.S. Patent & TMOtc/TM Mail Rpt Dt. #31

APPLICANT: Lone Star Steakhouse & Saloon, Inc.,
a Delaware Corporation

ADDRESS: 224 E. Douglas, Suite 700, Wichita, KS 67202

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LONE STAR

TRADEMARK



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